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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/026,363	02/19/98	ARGENTA L	WFU-WH4

QM41/0330
DANN DORFMAN HERRELL AND SKILLMAN
1601 MARKET STREET SUITE 720
PHILADELPHIA PA 19103-2307

EXAMINER	
LACYK,J	

ART UNIT	PAPER NUMBER
3736	

DATE MAILED: 03/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/026,353	ARGENTA et al
Examiner	**Group Art Unit**
LAEY K	3736

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-79 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-79 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. Claims 2, 7, 8, 34, 38, 44, 52, 54, 55, 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 3, the use of "locatable" is indefinite in that it is unclear whether the screen in located in such a position or not. In claims 7,44 and 55, it appears that the adhesive is on the seal and not on the cover. Also "adapted to" language should be used to avoid claiming a positive connection to the body. In claim 8, (iii), "adapted to" language should be deleted since both the reduced pressure supply means and the vacuum system are both positively claimed elements. In claims 38 and 60, "adapted to" language should be used , see claim 1. In claim 52, "the shield" lacks positive antecedent basis. In claim 54, the use of "sheet-like" is indefinite, in that the phrase "sheet- like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 16-18, 25, 28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13-15, 31, 32 of prior U.S. Patent No. 5,636,643. This is a double patenting rejection.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-15, 19-24, 26-27, 29-79 are rejected under the judicially created doctrine of double patenting over claims 1-12, 16-30, 33-40 of U. S. Patent No. 5,636,643 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an apparatus and methods for administering a reduced pressure treatment to a wound.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 31-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Flower, Jr or Wustmann.

8. Claims 1-4, 8, 12, 14-16, 19, 22, 31-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Svedman.

Svedman discloses a porous "screen" (11) that applies a negative pressure or suction that has a cover or shell (10) that has a greater surface area so as to be attached to the skin.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 9, 11, 13, 17, 20-21, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svedman in view of Flower, Jr.

Svedman discloses the claimed device except for the use of a collection device for collecting the fluid aspirated by the device. Flower, Jr. discloses a similar device and teaches that it is well

known to employ a container for collecting any fluid that is removed. Therefore a modification of Svedman to include a collecting device would have been obvious in view of the teachings of Flower, Jr. Further the particular ranges used for the reduced pressure are considered to have been an obvious modification, since to find the optimum or workable ranges of a device by routine experimentation when the general conditions are disclosed in the prior art, has been deemed to be an obvious modification.

11. Claims 1, 8, 12, 14, 16, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Barbieri.

12.Barbieri discloses a device that has a cover sealed over a wound that applies a negative or reduced pressure to the wound.

13. Claims 9, 11, 13, 17, 20, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barbieri in view of Svedman for the same reasons as discussed above.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is (703) 308-2995.

J.P. Lacyk

March 25, 1999

JOHN P. LACYK
PRIMARY EXAMINER